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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/666,437	09/22/2003	Thomas J. Kennedy III	P-4277-2-1-1 (SLDZ 2 0031	8315
24492	7590	11/02/2004	EXAMINER GORDON, RAEANN	
THE TOP-FLITE GOLF COMPANY, A WHOLLY OWNED SUBSIDIARY OF CALLAWAY GOLF COMPANY P.O. BOX 901 425 MEADOW STREET CHICOPEE, MA 01021-0901			ART UNIT 3711	PAPER NUMBER

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/666,437

Applicant(s)

KENNEDY ET AL.

Examiner

Raeann Gorden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 2,5-8,10 and 15-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,9 and 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4-30-04; 7-26-04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of claims 1, 3, 4, 9, and 11-14 in the reply filed on 8-12-04 is acknowledged. The traversal is on the ground(s) that the claims can be searched at the same time. This is not found persuasive because simply stating the species can be searched at the same time is not sufficient. Applicant further requested claims 3, 15, and 16 be considered. Claim 3 will be examined, however, claims 15 and 16 will not be examined because they claim two separate embodiments.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 9, 11, 12, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Keller et al (5,770,325). Regarding claims 1, 3, and 4, Keller discloses a dimpled golf ball with indicia made from ink. The ink jet printer and transfer medium are method steps and do not appear to further limit the final golf ball (see MPEP 2113).

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Regarding claim 9, the golf ball includes a topcoat (col. 4). Regarding claim 11, the indicia may be applied on a primer, which is placed on the cover (col. 5, lines 1-12). Regarding claim 12, primer coating inherently promotes adhesion. Regarding claim 14, the ink is a UV curable ink (abstract). The ink is inherently cured once applied to the golf ball.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keller in view of Hatch et al (5,817,735). Keller discloses the invention as shown above but does not disclose a primer comprising magnesium silicate. However, Hatch discloses a primer for a golf ball comprising magnesium silicate. One of ordinary skill in the art would have included a magnesium silicate in the primer to enhance the color of the ball thereby producing better clarity of the indicia (col. 6, lines 5-12).

Claims 1, 3, 4, 9, and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatch et al (5,817,735) in view of Mello et al (5,778,793). Regarding claims 1, 3, and 4, Hatch discloses a primer for a golf ball. The golf ball includes ink indicia stamped or painted on the surface. The ink jet printer and transfer medium are method steps and do not appear to further limit the final golf ball (see MPEP 2113).

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Hatch does not disclose a dimpled golf ball. However, Mello teaches a dimpled golf ball comprising indicia on the surface. Regarding claim 9, Hatch discloses the golf ball includes a topcoat (col. 6, lines 45-50). Regarding claims 11 and 12, Hatch discloses the golf ball includes a primer coat (col. 6, lines 45-50). Primer is well known for promoting adhesion. Regarding claim 13, Hatch discloses the primer includes magnesium silicate (col. 6, lines 5-12). Regarding claim 14, Mello teaches UV curable ink for indicia. One of ordinary skill in the art would have modified Hatch in view of Mello by implementing a UV curable ink to decrease the curing time.

### ***Conclusion***

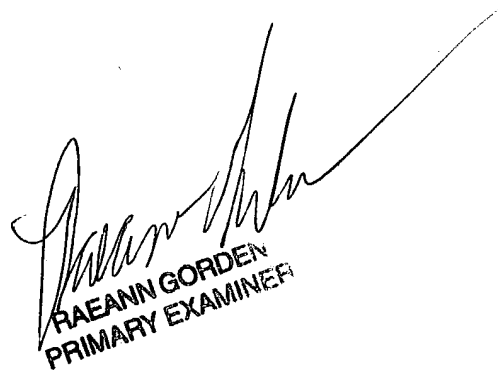
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rg  
October 28, 2004



RAEANN GORDEN  
PRIMARY EXAMINER